

Applicant : Timothy H. Bestor
Serial No. : 09/051,013
Filing Date: October 9, 1998
Page 3

- F. gene associated with an autoimmune disorder;
- G. gene associated with an inflammatory disorder; and
- H. gene associated with an infectious disease.

In response, applicant hereby elects with traverse the invention of Group I, claims 1-4, 6-26, 29 and 42-46, and the species of a gene associated with an infectious disease, upon which claims 1-4, 7-11, 15, 18, 22, 24-26 and 42-46 read.

REMARKS

Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement set forth in the May 21, 2002 Office Action. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I-IV are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. In this application there is a clear relationship between the subject matter of Groups I-IV. For example, claim 5 of Group II is merely an embodiment of claim 1 of Groups I and II. In addition, claims 34-41 of Group III and claim 46 of Group IV are dependent on claim 1 found in Groups I and II. Applicant therefore maintains that Groups I-IV are not independent and restriction

Applicant : Timothy H. Bestor
Serial No. : 09/051,013
Filing Date: October 9, 1998
Page 4

is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicant respectfully submits that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups II-IV would not require a serious burden once the prior art relevant to Group I has been identified.

Therefore, there would be no serious burden on the Examiner to examine Groups I-IV together in the subject application. Hence, the Examiner must examine these Groups on the merits.

Should the Examiner not be persuaded by applicant's argument above and the restriction requirement made final, applicant requests that under M.P.E.P. §809.03 the Examiner consider claim 1 a "linking claim", i.e., linking together the allegedly distinct inventions of Groups I and II. Groups I and II contain nearly identical set of claims and differ only in that Group I contains claims 4 and 6 whereas Group II contains claim 5. Applicant points out that these claims are all dependent on claim

Applicant : Timothy H. Bestor
Serial No. : 09/051,013
Filing Date: October 9, 1998
Page 5

1. Therefore, claim 1 should be deemed a linking claim. M.P.E.P. §809.03 provides that upon the allowance of the linking claim the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application.

In view of the foregoing, applicant maintains that restriction is not proper under 35 U.S.C. §121 and respectfully requests that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorneys invite the Examiner to telephone them at the number provided below.

Applicant : Timothy H. Bestor
Serial No. : 09/051,013
Filing Date: October 9, 1998
Page 6

No fee, other than the enclosed \$200.00 for a two-month extension of time, is deemed necessary. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
Tel. No. (212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231.

8/21/02
Date

Alan J. Morrison
Reg. No. 37,399